

REMARKS

Applicants have amended claims 168, 258, and 261 to address informalities and to more precisely claim the present invention. Importantly, the aforesaid amendments
5 are not made for any reasons related to patentability. Instead, these changes are merely cosmetic and are intended to merely clarify the Examiner's understanding of what was originally claimed in the Preliminary Amendment dated January 1, 2001. No new matter has been added.

10 Applicants believe that the following comments and foregoing amendments will convince the Examiner that the rejections set forth in the August 19, 2003 Office Action have been overcome and should be withdrawn.

Furthermore, Applicants are submitting herewith a
15 terminal disclaimer to limit the term of the patent resulting from this application to that of Applicants' U.S. Pat. No. 6,164,534 (the "'534 patent"). Applicants want to bring the '534 patent to the Examiner's attention since the Examiner may believe its claims are not patentably distinct
20 from (or in fact encompass) the present invention. Claim 1 from the '534 patent is illustrative:

1. A system for displaying programming to a user, the system comprising:

25 a printed matter having at least one machine recognizable feature;

5 a feature recognition unit having associated therewith a means for recognizing said feature and a transmitter for transmitting a coded signal in response to the recognition of said feature;

10 an intelligent controller having associated therewith a receiver for receiving said coded signal and means for accessing programming material; and

a display unit for presenting said programming material;

15 wherein said recognition unit, in response to the recognition of said feature, causes said intelligent controller to access said programming material and said display unit to execute or display said programming material.

20

I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium.

25 Specifically, the familiar printed medium is printed stationery comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material

related to the information contained in the printed stationery is displayed. Importantly, the present invention is designed to allow a user to access programming material related to the printed stationery.

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II. THE EXAMINER'S REJECTIONS

The Examiner rejected claims 168-173, 176-178, 195-196, 220, 229-232, 237-239, 242, 253, 258, and 260-263 under 35 U.S.C. § 103(a) as being unpatentable over
10 Withnall et al. U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall") in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as "Fields"). The Examiner opined that Withnall discloses a system that includes a feature recognition device that reads at least
15 one machine recognizable feature on stationery to display information on the display of a portable handset. However, the Examiner admitted that:

20 "Withnall fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming
25 material in response to receiving the coded signal." (August 19, 2003 Office Action, p. 3).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means

that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and transmits programming material in response to receiving a coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/sound/pictorial/electronic/media data" on a "television/workbook."

The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at the time of Applicants' invention:

"in order to provide the user a flexibility [sic] in viewing his/her desired/requested information ... and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall." (August 19, 2003 Office Action, p. 4).

Also, the Examiner rejected claims 174, 175, 180, 181, 183, 189, 190, 192, 193, 214-219, 222, and 223 under U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claim 168" in view of Roberts U.S. Patent No. 5,324,922 (hereinafter referred to as "Roberts") and Malec et al. U.S. Patent No. 5,287,266 (hereinafter referred to as "Malec"). The Examiner admitted that Withnall and Fields fail to teach online or home shopping and a cable television data link, and argued that Roberts discloses these features. According to the

Examiner, the combination of Roberts with Withnall and Fields would have been obvious and would provide:

5 "a faster internet system due to the benefit of
cable television transmitting/conducting
communication capability. Furthermore, such
modification would have been an obvious extension
as taught by Withnall/Fields to provide the user
[with] an alternative way of conducting the
shopping at his/her convenience." (August 19,
10 2003 Office Action, pp. 4-5).

Moreover, the Examiner admitted that Withnall, Fields,
and Roberts all fail to disclose an Integrated Service
Digital Network ("ISDN") data link which, according to the
15 Examiner, is disclosed by Malec. In the opinion of the
Examiner, the combination of Malec with Withnall, Fields,
and Roberts would have been obvious for providing:

20 "a more accurate and faster system due to the
benefit of ISDN networking line[s]. Furthermore,
such modification would have been an obvious
extension as taught by Withnall/Fields/Roberts
and would have been merely a substitution of
equivalent[s]." (August 19, 2003 Office Action,
p. 5).

25 Next, the Examiner rejected claims 179, 182, 184, 186-
188, 191, 194, 199-201, 203, 204, 209, 210, 213, 221, 224-
228, 236, 241, 243-245, 256, and 259 under 35 U.S.C. §
103(a) as being unpatentable over Withnall as modified by
30 Fields "as applied to claims 168 and 258" in view of
Bravman et al. U.S. Patent No. 5,401,944 (hereinafter
referred to as "Bravman"). The Examiner admitted that

Withnall and Fields fail to teach displaying information on a wireless communication device. According to the Examiner, Bravman teaches a remote unit providing travel-related information, and the combination of Withnall, 5 Fields, and Bravman would have been obvious for providing:

10 "a more compact system wherein the portable handheld communication device can be carried along with the user without causing any inconvenience, and thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields." (August 19, 2003 Office Action Summary, p. 6).

15 Also, the Examiner rejected claims 197, 202, and 205 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields "as applied to claim 168" in view of Waterbury German Patent No. DT 24 52 202 A1 (hereinafter referred to as "Waterbury"). The Examiner 20 admitted that Withnall and Fields fail to teach an invisible machine recognizable feature, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Waterbury with Withnall and Fields would have been obvious for providing:

25 "an improved security system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, and thus preventing an unauthorized individual(s) from manipulating the data. Furthermore, such modification would 30 have been an obvious extension as taught by

Withnall/Fields." (August 19, 2003 Office Action, pp. 6-7).

Additionally, the Examiner rejected claims 198 and 212
5 under 35 U.S.C. § 103(a) as being unpatentable over
Withnall as modified by Fields "as applied to claim 168" in
view of Tannehill et al. U.S. Patent No. 5,158,310
(hereinafter referred to as "Tannehill"). The Examiner
admitted that Withnall and Fields fail to teach a magnetic
10 code strip, which is argued to be taught by Tannehill.
According to the Examiner, the aforementioned combination
would have been obvious for providing Withnall and Fields
with an alternative method for encoding data.
"Furthermore, such modification would have been merely a
15 substitution of equivalents for storing data." (August 19,
2003 Office Action, p. 7).

Further, the Examiner rejected claims 206-208 and 211
under 35 U.S.C. § 103(a) as being unpatentable over
Withnall as modified by Fields "as applied to claim 168" in
20 view of Schach et al. U.S. Patent No. 5,397,156
(hereinafter referred to as "Schach") and Waterbury. The
Examiner admitted that Withnall and Fields fail to teach a
watermark, which is argued to be taught by Schach. In the
Examiner's opinion, the combination of Schach with Withnall
25 and Fields would have been obvious for aesthetic purposes.

"[S]uch modification would have been an obvious extension as taught by Withnall/Fields." (August 19, 2003 Office Action, p. 8).

The Examiner then admitted that Withnall, Fields, and
5 Schach fail to teach an invisible watermark, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, and Waterbury would have been obvious for providing:

10 "an improved security system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, and thus preventing an unauthorized individual(s) from manipulating the data. Furthermore, such modification would
15 have been an obvious extension as taught by Withnall et al/Fields/Schach et al." (August 19, 2003 Office Action, p. 8).

Also, the Examiner rejected claims 185, 233-235, 240, 241, 246-252, 254, 255, and 257 under 35 U.S.C. § 103(a) as
20 being unpatentable over Withnall as modified by Fields "as applied to claims 168 and 258" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall and Fields fail to teach a display unit comprising a "personal
25 planner/phone/pager," which the Examiner argued is taught by Morales. In the Examiner's opinion, combining Withnall, Fields, and Morales would have been obvious to provide:

"the user with the flexibility of selecting his/her desired display unit that is most

5 convenient to [sic] his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields." (August 19, 2003 Office Action, p. 9).

III. **THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN**

10 The Examiner rejected claims 168-173, 176-178, 195-196, 220, 229-232, 237-239, 242, 253, 258, and 260-263 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Fields. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall and Fields. In order for a claimed invention to be obvious in view of a combination of
15 references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the
20 claim limitations (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall and Fields exists.

25 "Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to

produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The Examiner contended that it would have been obvious to combine the teachings of Withnall and Fields to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has cited only purported benefits of this combination without pointing to what motivation is provided by the references themselves. Applicants submit that no combination of these references would have been obvious to one of skill in the art at the time of Applicants' invention. Specifically, Withnall discloses a system for utilizing barcodes on commuter tickets to test for validity. The Examiner suggests that "travel information which can be retrieved once barcode [sic] on the ticket has been read can be considered programming material...associated with the barcode." (August 19, 2003 Office Action, p. 10) Applicants respectfully submit however, that this does not constitute programming material. The "travel information" referred to by the Examiner is encoded within the barcode on the ticket. The system of Withnall reads this information from the barcode,

it does not retrieve it from a separate database. The barcode or the data encoded therein do not themselves constitute programming material. Indeed, the only interaction the barcode has with a database is a mere
5 validity check, i.e., the comparison of data on the ticket to stored reference data.

This purpose is far removed from the intent of the training system disclosed by Fields. The training system of Fields is used to provide a user with audio/visual
10 output from a videodisc player coinciding with material presented in a training manual. Fields relies on a read-only videodisc thereby sacrificing updatability and flexibility. In fact, Fields does not even contemplate the ability to interface with a remote server or an updatable
15 video source. Thus, there is no suggestion to combine a travel ticket verification system that does not provide programming material with a training system that automatically cues to a certain frame on a videodisc. The mere fact that Fields and Withnall can use a barcode is an
20 insufficient basis to suggest their combination.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for

obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully
5 submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

10 "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper
15 when resolving the question of nonobviousness in a court of law."

Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No
20 such suggestion or motivation is provided by the references themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to combine Withnall and Fields, there is no expectation of
25 success for the combination of these references, and any possible resulting device would not teach or suggest all of the limitations of the rejected claims. Withnall discloses

a machine capable of scanning a bar code on a commuter ticket and subsequently displaying the validity of the ticket based on information stored in a memory means. Fields discloses a system that reads a bar code on a training manual for playing corresponding material from a videodisc. Applicants respectfully submit that the combination of Withnall and Fields cannot be successfully combined to disclose the means for accessing programming material associated with a database or the printed stationery having a machine recognizable feature of the claimed invention. Importantly, amended claims 168, 258, and 261 all disclose the accessing of programming material resulting from recognition of a machine recognizable feature on office supply stationery. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user will be provided with the most recently updated version of the associated information (or programming material) upon scanning a stationery item. This is not possible with the combination of Withnall and Fields. Furthermore, any attempt of implementing the videodisc player of Fields with Withnall would require the videodisc player to be located on a vehicle, e.g., a bus. Therefore, anytime information must be updated, a new videodisc must

be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can change each time a ticket is used and could require a new videodisc to be employed every time a ticket is used.

5 Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other such audio/visual material because the radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In
10 particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, a system for achieving such transmission would need to be invented and implemented for remotely accessing such material.

15 Again, the stationery having a machine recognizable feature as claimed is not disclosed within the combination. The Examiner claims that Withnall discloses a printed stationery having a machine recognizable feature. Applicants respectfully submit that stationery is not even
20 mentioned within Withnall. Applicants intend "stationery" to refer to paper that can be printed or written on for correspondence or recordation purposes and is commonly used by an individual or an entity and/or purchased from an office supply store or stationer. Such supplies may

include, for example, letterhead paper, envelopes, notepads, journals, invitations, greeting cards, postcards, resume paper, etc. Withnall, which discusses commuter ticketing systems, naturally does not disclose any such items, and therefore cannot be used to cover the stationery of the claimed invention.

The Examiner relies on the tenth edition of the MERRIAM-WEBSTER COLLEGE DICTIONARY for a broad definition of "stationery": "materials (as paper, pens, and ink) for writing or typing." (August 19, 2003 Office Action, p. 10). Thus, the Examiner concluded that "a ticket disclosed in Withnall is a paper product on which information can be written or printed." *Id.* So construed, the term "stationery" is no limitation at all.

The commuter tickets of Withnall are produced having enough information such that they are complete when they reach the market. In contrast, the stationery of the present invention allows a user to access additional information beyond the information provided on the stationery.

In sum, any attempt to combine Withnall and Fields to create the present invention would be unsuccessful and fail to provide the flexible, updateable system for obtaining and surveying correlated programming material of the

claimed invention as opposed to a comparison of the identity of a printed code with a code stored in a database. Moreover, the dynamic programming material and stationery comprising a machine recognizable feature of the
5 claimed invention are not disclosed by the combination of these references.

In view of the foregoing, base claims 168, 258, and 261 cannot be unpatentable over Withnall and Fields. The remaining rejected claims are dependent on these claims and
10 contain all of the limitations of their respective base claims. Therefore, these dependent claims are also not unpatentable over these references.

In all subsequent rejections, the Examiner noted the deficiencies of the Withnall and Fields combination
15 regarding matter disclosed in dependent claims and appended various other references including Roberts, Malec, Bravman, Waterbury, Tannehill, Schach, and Morales to the combination in order to provide the additional features of the dependent claims. However, the combination of Withnall
20 and Fields has been shown to be not only improper, but also to lack the disclosure of each and every element of the base claims. Because this combination is improper and incomplete, any further combination of references with Withnall and Fields would also be improper. Thus,

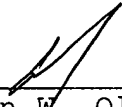
Applicants respectfully submit that all remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

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